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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,560	10/31/2003	Thomas Grafenauer	P27123	8411
7055 7590 01/27/2009 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER FERGUSON, LAWRENCE D				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
01/27/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

### Office Action Summary

**Application No.**

10/697,560

**Applicant(s)**

GRAFENAUER, THOMAS

**Examiner**

LAWRENCE D. FERGUSON

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In view of the Appeal Brief filed on October 14, 2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.1 11 (if this Office action is non-final) or a reply under 37 CFR 1.1 13 (if this Office action is final); or,

(2) request reinstatement of the appeal.

2. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1k131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections – 35 USC § 103(a)***

4. Claims 1-3, 8-9 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (U.S. 6,449,918).

Nelson discloses a panel having a reinforcing substrate (support board) having a top wear surface and a bottom surface with a backing layer surface attached to the

substrate (column 11, lines 41-46 and column 15, line 63 through column 16, line 2) where the base member is made from wood based materials (column 16, lines 30-47) where it is expected for the woodbased particle materials to be glued or binned together. The top wear surface of the panels comprises decorative laminates prepared by heat and pressure consolidation, which have an embossed simulated wood grain finish (column 2, lines 3-15) where water is used to penetrate from the underside of the flooring panel (column 14, lines 16-20). Nelson further discloses the panels included recesses formed (column 20, lines 64-65).

Paragraphs 0015-0016 of the instant specification discloses the density of on the top side of a support board is lower than the density of the underside when the top surface is stamped and water is applied to the underside prior to the material being heated and compressed. Because Nelson discloses the top side is embossed (stamped) and the underside has water penetrated prior to the material being heated and compressed, it is expected for the top side to have a structured surface, where the density on the top side of the support board is lower than the density of the support board on the underside, with the density distribution through a thickness of the board is substantially parabolic in shape, as in claims 1, 8 and 16-21. In claim 19, the phrase, "comprises a structure composed of a stamping" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product

was made by a different process.” In *re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

Although Nelson does not teach the gluing factor amount or density of the layers as in claims 2-3 and 9, density and gluing factor are optimizable. In the absence of any evidence to the contrary, it would have been obvious to one of ordinary skill in the art to optimize the layers of the panel because discovering the optimum or workable range involves only routine skill in the art. The density and gluing factor directly affects the durability of the panel. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215. Additionally, there is also no clear teaching away from the density and gluing factor of the panel by Nelson, as the reference does not exclude any values for the density or gluing factor.

***Claim Rejections – 35 USC § 103(a)***

5. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (U.S. 6,449,918) in view of Clausi (U.S. 5,855,832).

Nelson is relied on for instant claim 1 as above. Nelson does not disclose the panel comprising UF and isocyanates, as in claims 4-7. Clausi teaches a compressed wood fiber material having a binding agent including urea formaldehyde (UF) and isocyanate (column 1, lines 12-20, column 13, lines 35-40 and column 14, lines 37-39). Moriau and Clausi are both related to compressed woodbased fiber material. It would have been obvious to one of ordinary skill in the art for the adhesive material of Nelson

to comprise UF and isocyanate because Clausi teaches these materials are conventional binding (adhesive) materials. Although neither reference teaches the gluing factor for isocyanates, gluing factors are optimizable. In the absence of any evidence to the contrary, it would have been obvious to one of ordinary skill in the art to optimize the core (support board) of the panel because discovering the optimum or workable range involves only routine skill in the art. The gluing factor directly affects the durability of the panel. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215.

### ***Response to Arguments***

6. Applicant's arguments regarding the rejection made under 35 U.S.C. 103(a) as being unpatentable over Moriau et al. (U.S. 6,006,486) are moot based on grounds of new rejection.

Applicant's arguments regarding the rejection made under 35 U.S.C. 103(a) as being unpatentable over Moriau et al. (U.S. 6,006,486) in view of Clausi (U.S. 5,855,832) are moot based on grounds of new rejection.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-

272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil, can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lawrence Ferguson/  
Patent Examiner, Art Unit 1794

/Bruce H Hess/  
Primary Examiner, Art Unit 1794